

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. ANDERSON,
MARILYN M. POLANSKY and NOELLA A. BRYDEN,

Appeal No. 2003-0570
Application 09/414,645

ON BRIEF

Before, WILLIAM F. SMITH, PAWLIKOWSKI, and GREEN, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2 through 6. Claim 1 has been canceled.

Claim 2 is representative of the subject matter on appeal and is set forth below:

2. A composition useful as a nutritional supplement comprising chromium-histidine complex in an amount effective for improving the absorption of chromium in mammals and an ingestible carrier.

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The examiner relies on the following references as evidence of unpatentability:

Ashmead	5,614,553	Mar. 25, 1997
Jensen	4,167,564	Sep. 11, 1979

Claims 2 through 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Jensen in view of Ashmead.

OPINION

We have carefully reviewed appellants' Brief and Reply Brief, and the examiner's Answer. This review has led us to conclude that the examiner's 35 U.S.C. § 103 rejection is not well-founded for the reasons set forth below.

I. Prosecution History

In the Office Action mailed May 9, 2000 (Paper No. 5), the examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Adel-Monem. The examiner also rejected claims 2-6 under 35 U.S.C. § 102(b) as being anticipated by Ashmead and claims 1-6 under 35 U.S.C. § 103(a) over Jensen in view of Ashmead. In response to this Office Action, appellants filed a Request for Reconsideration (Paper No. 6). In this Request, appellants argued the data of Table 1 found on page 8 of the specification. In response to this Request, the examiner, in the

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Office Action mailed November 15, 2000 (Paper No. 7), maintained each of the rejections. In this Office Action, on pages 5-6, the examiner commented on the data of Table 1 by stating "[i]n response to applicant's argument that the references fail to show the unique properties of histidine, it is noted that the unique features upon which application relies are not recited in the rejected claims".

In response to the Office Action of Paper No. 7, appellants filed a Response/Amendment on February 20, 2001 (Paper No. 9). In this Response, on page 13, appellants argued that the examiner's position regarding the data of Table 1 "is somewhat puzzling . . .".

The examiner then issued an Advisory Action (Paper No. 10), and indicated that the rejection of claim 1 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) was overcome, but maintained the other rejections. The examiner provided no further comments in response to appellants' arguments concerning the data of Table 1, found on pages 5-13 of appellants' Response of Paper No. 9.

In response to the Advisory Action, appellants filed their Brief on July 11, 2001.

II. The 35 U.S.C. §103 Rejection

In response to appellants' arguments in their Brief, the examiner withdrew the 35 U.S.C. § 102(b) rejection, but maintained the 35 U.S.C. § 103(a). This rejection is set forth on pages 3-5 of the Answer.

In the Brief, appellants again repeated their arguments regarding the data of Table 1 found on page 8 of their specification. In response, the examiner stated:

"While the examiner agrees with Appellant's interpretation of the results shown in Table 1 (argument #2), it is noted that the features upon which Appellant relies (i.e., the differences among the chromium-amino acid complexes tested) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims . . .".

Answer, page 8. The examiner reiterated this position on pages 9 and 11 of the Answer.

Before reaching a determination regarding the data of Table 1, we first note that we agree with the examiner that Jensen discloses chromium among the listed essential metals which can be assimilated in the form of chelated coordination complexes with amino acids, and that Jensen lists histidine among the alpha amino acids suitable for the invention. Appellants argue that Jensen's examples do not disclose complexes of chromium-histidine complex. Brief, page 6. However, we note that a reference is

not limited to its examples, but is available for all that it clearly discloses and suggests. See In re Widmer, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965). Here, as stated by the examiner, Jensen teaches that metabolically essential metals and trace elements, including chromium, can be made available in the form of chelated coordination complexes with amino acids. Jensen teaches that such amino acids include histidine. See column 1, lines 50 through 57.

Also, we are mindful that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448-49, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986) (holding that district court, by failing to consider a prior art reference in its entirety, ignored portions of the reference that led away from obviousness). In the instant case, however, to assert (as appellants have done) that Jensen's specific teaching of chromium (from the selection of listed metals) and histidine (from the selection of amino acids) is picking and choosing from a myriad of choices skews what Jensen fairly suggests as a reference.

We therefore determine that one of ordinary skill in the art would have been led to the selection of a chromium-histidine complex in view of a fair reading of the teachings found in Jensen. We therefore determine that the examiner has set forth a prima facie case of obviousness. We need not comment on Ashmead in reaching this determination.

A prima facie case of obviousness is rebuttable by proof that the claimed invention possesses unexpectedly advantageous or superior properties. In re Papesch, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963).

Beginning on page 7 of the Brief, appellants argue that the results in Table 1 demonstrate an unexpectedly superior increase in absorption as compared with the other complexes listed therein. Appellants argue that this data therefore establishes that the selection of histidine for complexation with chromium provides unexpected benefits with respect to chromium absorption.

Beginning on page 8 of the Answer (as discussed above), the examiner concludes that this data is unconvincing for the reasons quoted on page 4 of this decision.

On pages 3 through 4 of the Reply Brief, appellants argue that the examiner acknowledges that Table 1 shows superior and unexpected properties, but dismisses the data because these properties are not recited in the claims. Appellants argue that the results presented in Table 1 cannot be construed as a

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limitation to a claim. We agree for the following reasons.

As stated supra, a prima facie case of obviousness is rebuttable by proof that the claimed invention possesses unexpectedly advantageous or superior properties. Id. It is not disputed that Table 1 demonstrates unexpected, superior results regarding absorption, as compared to other chromium complexes. This is all that is required. Id.

Throughout the prosecution history of this case, appellants have consistently argued that the data of Table 1 demonstrates unexpectedly superior properties of their claimed invention. The examiner's position on this data that these properties must be claimed (and because they are not claimed, the data is unconvincing) is not what is required according to the aforementioned case law. Because the examiner's position is therefore incorrect, we determine that appellants' rebuttal evidence is sufficient to overcome the prima facie case of obviousness.

We therefore reverse the rejection.

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III. Conclusion

The 35 U.S.C. § 103 rejection of claims 2 through 6 over
Jensen in view of Ashmead is reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BEVERLY A. PAWLIKOWSKI)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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LORA M. GREEN)	
Administrative Patent Judge)	

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